

REMARKS/ARGUMENT

New claim 35 has been added and claim 26 has been amended. New claim 35 is substantially identical to prior dependent claim 25, written as an independent claim. Claim 26 has been amended to be dependent on claim 35.

The Office Action asserted that claim 26 submitted with the prior response was not part of the elected invention. Applicants strongly disagree. Claim 26 was a further sub-species of the invention defined by prior claim 25 (now claim 35), in which another material is dispersed in the anionic polymer. However, the presence of that additional material does not bring the subject matter out of the elected invention.

Claims 17, 19 and 24 were rejected in the original Office Action under the second paragraph of 35 USC 112, as being indefinite. The claims were rejected because they embraced non-elected subject matter. This rejection is respectfully traversed.

Claims 17, 19 and 24 have been cancelled. Applicant contends that all of the presented claims are directed to the elected species. In the claims, the film-forming binder is starch, the anionic polymer is a hydrolyzed copolymer of styrene-maleic anhydride; and the cationic monomer is polyamidoamine-epichlorohydrin. Dependent claim 26 further defines the hydrolyzed copolymer of styrene-maleic anhydride as having a copolymer of styrene-acrylic ester dispersed therein.

Claims 13, 14, 18, 19 and 24 were rejected under 35 USC 102(b) as being anticipated by Burdick, US 6,359,040; while claims 17 and 25 were rejected under 35 USC 103(a) as being obvious over Burdick in view of Gray et al, US 3,297,657. These rejections are respectfully traversed.

All of the rejected claims have been canceled.

The new claims are neither anticipated, nor obvious over the Burdick '040 patent, whether viewed alone or in combination with the Gray '657 patent.

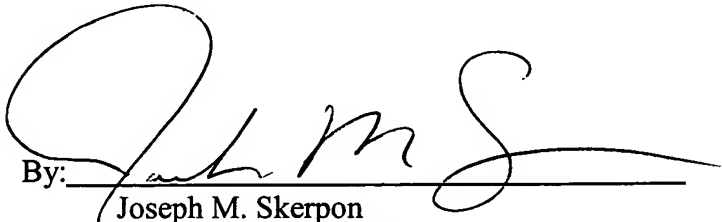
Burdick '040 describes an aqueous composition comprising a first ionic polymer, generally an anionic polymer and a viscosity promoter having a net ionic charge opposite to that of the ionic polymer, generally comprising a cationic polymer. The patent alludes to the use of the described composition for the surface sizing of paper (see col. 3, lines 60 et seq.). Anionic polymers are identified at col. 9, lines 42-67; while cationic polymers are identified at the top of column 10 (see also col. 10, line 51 to col. 11, line 2). While SMA resins appear as an anionic polymer viscosity promoter at col. 11, lines 3-6), there is no mention or remote suggestion of using hydrolyzed SMA (with or without a dispersed polymer phase), particularly in combination with a polyamidoamine-epichlorohydrin resin. As demonstrated by the results presented in Example 4 of the pending

application, this combination of ingredients is particularly effective as a surface size, exhibiting a combination of both superior hydrophobicity (as measured by HST) and excellent surface integrity (as measured by Adams Wet Rub). Such a combination of properties is not suggested by the cited references.

On the basis of the forgoing, applicants request reconsideration of the pending claims.

Respectfully submitted,

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